

## REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application is respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1, 2, 4-6, 8, 10, 13, 14, 16, 19 and 20-26 were pending. By the present response, claims 1, 13, 16, 20, 22 and 23 have been amended. Thus, upon entry of the present response, claims 1, 2, 4-6, 8, 10, 13, 14, 16, 19 and 20-26 remain pending and await further consideration on the merits.

Support for the foregoing claim amendments can be found in at least the original claims.

### ***CLAIM REJECTION UNDER 35 U.S.C. §102***

Claims 1, 2, 4-6, 8, 10, 13, 14, 16 and 19 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 5,481,464 to Ramsden (hereafter "*Ramsden*"), on the grounds set forth in paragraphs 2 and 8 of the Official Action. This rejection is respectfully traversed.

Applicants traverse the rejection on the same basis previously set forth at length in the response filed on June 26, 2006.

It is asserted in paragraph 8 of the Official Action that:

[T]he examiner is going to maintain his position that claims 1, 2, 4-6, 8, 10, 13, 14, 16, 19 are only entitled to a filing date of 8/2/1994. The reason for this is that the scope of some means plus function language is not supported in 07/678,863, which means that applicant does not have support for the scope of what is claimed back to 1991. With respect to the limitation of "means for inputting information relating to the destination of the item from the customer," the specification from 07/678,863 disclosed a touchscreen or conventional computer keyboard as being the input

mechanism. The instant specification is setting forth guidance to the examiner that the means plus function language is to be given a different scope than that originally disclosed in the 07 case, because now the means language covers the structure of the voice recognition system that is not explicitly disclosed in 07/678,863.

By the present response, Applicants have amended the present specification so as to eliminate all references to a voice recognition system. Thus, the support for the above quoted limitation is now the same as the support appearing in Applicants' previous application Serial No. 07/678,863 filed on April 1, 1991. Therefore, claims 1, 2, 5-6, 8, 10, 13, 14, 16 and 19 are entitled to an effective filing date of April 1, 1991.

By contrast, Ramsden has an earliest possible effective filing date of April 10, 1991. Ramsden does not qualify as prior art against the presently claimed invention. Reconsideration and withdrawal of the rejection is respectfully requested.

It is further asserted in paragraph 8 of the Official Action in the limitation appearing in claim 10 of "means for transmitting a manifest to a remote location" is not supported by the disclosure of 07/678,863. This assertion is respectfully traversed. The April 1, 1991 disclosure contained in 07/678,863 makes it clear that the device described therein stores transactional information and is capable of generating a manifest, and that the device is structured such that such information can be remotely transmitted via a bus/modem-based configuration.

As illustrated, for example, in Figure 26 of the 07/678,863 disclosure, a manifest may be generated from the information stored by the device (note the options for "print previous manifest" and "search for a shipment"). Obviously, in order to retrieve such information it must have been stored in a memory of the system or device. See also, Figures 18b, 19b, 20b, 21b, 23a-b, 24b, and 26.

As described on page 2, lines 26- 28 of the 07/678,863 disclosure: "When a machine operator (e.g., a convenience store clerk) inputs an appropriate instruction at the end of the day, a hard-copy manifest of packages received by the machine is generated." The disclosed system and device is physically configured to permit remote communication of the manifest. See, e.g., Figures 12b-12c (the computer 1201 is connected to the bus 1200, which is connected to a modem 1262, which in turn is connected to the telephone line 1264). See also Figure 12a; elements 1208, 1210 and 1212, and Figure 12b; computer 1201.

In light of the above, claim 10 is clearly supported by the 07/678,863 disclosure of April 1, 1991. As such, Ramsden fails to qualify as prior art against claim 10. Reconsideration and withdrawal of the rejection is respectfully requested.

Should the rejection be maintained on the basis that claim 10 is not entitled to the filing date of the 07/678,863 disclosure, applicants respectfully request that the Examiner clarify how the limitation "means for transmitting a manifest to a remote location" is being interpreted. In this regard, applicants note the interpretation afforded similar means plus function limitations in paragraph 3 of the Official Action:

The examiner wants to note that the act of communicating the charges information to a central location for the billing is not part of the claim, only the structure that is used to accomplish this step. The intended use of the communication means does not define over the prior art because the prior art is fully capable of doing what is claimed due to the fact that there is a modem present that can communication [sic] with the remote host 150. . . (emphasis added)

Should the rejection be maintained, applicants respectfully request that the Examiner include commentary such as that quoted above which explains how the

"means for transmitting a manifest to a remote location" limitation of claim 10 is being interpreted.

Claims 1, 5, 6, 8, 10, 13, 14, 16 and 19-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,313,404 to Wu (hereafter "Wu") on the grounds set forth in paragraph 3 of the Official Action. Reconsideration and withdrawal of the rejection is respectfully requested.

Applicants traverse the assertions contained in paragraph 3 of the Official Action that Wu anticipates each of the above listed claims. However, in order to advance prosecution, applicants submit herewith Declarations pursuant to 37 C.F.R. § 1.131 of inventors Asher Gill and John B. Daron that establish that the subject matter contained in at least each claim rejected above was actually reduced to practice prior to the earliest effective filing date of the Wu disclosure.

Applicants note that Wu issued from application Serial No. 0/536,496 filed June 11, 1990, which was a continuation-in-part of application Serial No. 06/920,648 filed October 20, 1986.

In paragraph 3 of the Official Action, portions of the disclosure of Wu relied upon to reject the above listed claims, is identified as follows:

The means for accepting identification information is the money card reader 711 that is disclosed in column 4, lines 4-9. Applicant has claimed that the means for accepting identification information relating to eventual payment from the customer comprises a means for receiving and reading a credit card. The examiner notes that the structure defined by this language is the same as found in Wu's money card reader 711. The structure is the same. The means for communicating the charges to a central location for billing the charges is satisfied by the disclosure in column 3, line 65 to column 4, line 3, where it is disclosed that a modem 151 may be added to the system so that data communication with a remote host 150 can occur.

At least the above quoted portion of the Wu disclosure which is relied upon to reject the claims first appeared in the continuation-in-part (application Serial No. 07/536,496 filed June 11, 1990). Thus, the effective filing date of the Wu disclosure relied upon to reject the claims is June 11, 1990.

As noted above, the Declarations of Asher Gill and John B. Daron Pursuant to 37 C.F.R. § 1.131 establish that the subject matter contained in at least each claim rejected above was actually reduced to practice prior to June 11, 1990. Thus, the Wu disclosure has been antedated and is not available as prior art for purposes of rejecting the above identified claims.

***CLAIM REJECTIONS UNDER 35 U.S.C. § 103***

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being obvious over Wu in view of U.S. Patent No. 4,641,239 to Takesako (hereafter "Takesako") on the grounds set forth in paragraph 6 of the Official Action.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being obvious over Wu in view of U.S. Patent No. 5,042,015 to Stringer (hereafter "Stringer") on the grounds set forth in paragraph 7 of the Official Action.

As explained above, Wu has been eliminated as prior art with respect to claim 1, from which claims 2 and 4 depend. Thus, these rejections have been obviated.

**CONCLUSION**

From the foregoing, further and favorable action is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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